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10/519,861	12/29/2004	Yasuo Ishiguro	82478-9900	9295

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EXAMINER

BADAWI, SHERIEF

ART UNIT	PAPER NUMBER
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2169

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/519,861	Applicant(s) ISHIGURO ET AL.	
	Examiner Sherief Badawi	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 20/021-99140.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application having Application No. 10/519861 has a total of 14 claims pending in the application; there are 3 independent claims and 11 dependent claims, all of which are ready for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. 1.63.

Drawings

The drawings are objected to because **identification of drawings is not provided**.

The identification of drawings should be provided according to M.P.E.P 1.84(c).

(c) Identification of drawings. Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this application is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to M.P.E.P 1.21(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the

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remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claim 12** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the ID/purpose". There is insufficient antecedent basis for this limitation in the claims.

In claim 12, it is suggested to replace "--the ID/purpose --" with --an-- or replace "to Claim 9" with "to Claim 11"

Claim Objections

5. **Claims 2-12** are objected to because of the following informalities:

As per **Claims 2-12**, the Claims are dependant claims that refer to a data searching apparatus listed in the independent claims.

Claims 2-12, recite "A data searching apparatus", it is suggested to replace "--A--" with "--the--"

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 2, 4, 6, 9, 13 and 14** are rejected under 35 U.S.C. 102(e) as being anticipated by Subramaniam et al. (U.S. 6,728,702).

As per **Claims 1, 13 and 14**, Subramaniam discloses A data searching apparatus for searching a database based on a search criterion entered in a corresponding data-entry field by a user, the data searching apparatus comprising: a field information holding unit operable to hold field information indicating one or more of a plurality of data-entry fields that correspond one-to-one with a plurality of search categories structuring the database; **[To perform a search, a user generally selects or specifies search criteria through the Search Center User Interface; Paragraph.71; lines 1-2.In the case of using a search engine such as Fulcrum, these business component fields map directly to a Fulcrum column (e.g., in the Fulcrum search table) and are indexed as part of the regular indexing process as described herein; Paragraph.224, lines 4-6. For example, create a search definition called "Call Center Search Definition". As described above,**

a search definition is a group of search categories; Paragraph.234, lines 2-4]. A field display unit operable to display the one or more data-entry fields indicated by the held field information, and to hide any of the plurality of data-entry fields not indicated by the held field information. [In addition, a new view corresponding to the selected search option is built; Paragraph.106, lines 12-14].

As per Claim 2 and 4, the rejection of claim 1 is hereby incorporated by reference; Subramaniam discloses a data searching apparatus according to claim 1, further comprising: a category accepting unit operable to accept, from the user, a specification of one or more of the plurality of search categories;**[user selects a Search Category (or Search Categories); Paragraph.71, line 8].** An update unit operable to update the held field information, so as to indicate one or more data-entry fields corresponding to the one or more search categories; **[the business component "Literature" is access control enabled, then a user will only see categories and literature items under categories that he or she has access to; paragraph.176, lines 4-6].**

As per Claim 6, the rejection of claim 1 is hereby incorporated by reference; Subramaniam discloses a type display unit operable to display a list of types into which the plurality of search categories are classified **[user generally selects or specifies search criteria through the Search Center User Interface; Paragraph.71, lies 1-2].** a type accepting unit operable to accept, from the user, a selection of a desired type from the displayed list of types; **[user generally selects or specifies search criteria through the Search Center User Interface; Paragraph.71, lies 1-2].** a category display unit operable to display a list of search

categories that are classified as the selected type, when the selection of the type has been accepted; **[user selects a Search Category (or Search Categories); Paragraph.71, line 8].** a category accepting unit operable to accept, from the user, a selection of one or more search categories from the displayed list of search categories; **[Search Category objects representing Search Categories can be created and associated with Search Indices or Search Definitions, as described above in the Search Objects section; Paragraph.71, lines 5-7].** update unit operable to update the field information based on the accepted selection, when the selection of the search categories has been accepted; ; **[the business component "Literature" is access control enabled, then a user will only see categories and literature items under categories that he or she has access to; paragraph.176, lines 4-6].**

As per Claim 9, the rejection of claim 1 is hereby incorporated by reference; Subramaniam discloses the field information holding unit holds pieces of the field information each corresponding to a different search purpose, the apparatus further comprises a search purpose accepting unit operable to accept a search purpose selected by the user before starting a database search, and the field display unit displays the data-entry fields indicated by one of the pieces of the field information that corresponds to the accepted search purpose; **[the user can select a new search category and navigate to the appropriate view corresponding to the newly selected search category; paragraph.107, lines 7-9].**

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 3, 5, 7, 8, 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam et al. (U.S. 6,728,702) further in view of Dasan (5,761,662)

As per **Claim 3**, the rejection of claim 2 is hereby incorporated by reference; Subramaniam does not disclose field information holding unit is a nonvolatile recording medium, and when the user performs a database search during a period in which the updated field information is held without further update, the field display unit displays the one or more data-entry fields indicated by the updated field information, and hides any of the plurality of data-entry fields not indicated by the updated field information.

However Dasan discloses field information holding unit is a nonvolatile recording medium, and when the user performs a database search during a period in which the updated field information is held without further update, the field display unit displays the one or more data-entry fields indicated by the updated field information, and hides any of the plurality of data-entry fields not indicated by the updated field information. **[The first application program examines a database**

of information and automatically retrieves a subset of the information from the database based upon which information is of interest to the user as specified in the user-defined profile; Paragraph.10, lines 10-13].

Subramaniam and Dasan are analogous art because they are from the same field of endeavor of Database information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Dasan. One having ordinary skill in the art would have found it motivating to use personalized information retrieval system of Dasan into the full-text search and query system of Subramaniam for the purpose retrieving data from a server based upon a defined and stored user profile of desired information; **[Paragraph.28, lines 1-3] as taught by Dasan.**

As per Claims 8 and 11, the rejection of claim 1 is hereby incorporated by reference; Subramaniam does not disclose the field information holding unit holds pieces of the field information each corresponding to a different user ID, the apparatus further comprises an ID accepting unit operable to accept a user ID inputted by the user before starting a database search, and the field display unit displays the data-entry fields indicated by one of the pieces of the field information that corresponds to the accepted user ID.

However Dasan discloses the field information holding unit holds pieces of the field information each corresponding to a different user ID, the apparatus further comprises an ID accepting unit operable to accept a user ID inputted by the user before starting a database search, and the field display unit displays the data-

entry fields indicated by one of the pieces of the field information that corresponds to the accepted user ID; **[retrieving information based on a user-defined profile (e.g. a personalized newspaper). A user-controlled client establishes communication with a stateless server, the server presenting a list of options to the client (e.g. via Hypertext Transfer Protocol (HTTP) exchanges) between the server and the client. The client provides an identification of the user-defined profile. The server engages a first application program (e.g. via a Common Gateway Interface (CGI)), the first application program retrieving the user-defined profile wherein the user-defined profile identifies information which is of interest to the user; Paragraph.10, lines 1-10].**

Subramaniam and Dasan are analogous art because they are from the same field of endeavor of Database information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Dasan. One having ordinary skill in the art would have found it motivating to use personalized information retrieval system of Dasan into the full-text search and query system of Subramaniam for the purpose retrieving data from a server based upon a defined and stored user profile of desired information; **[Paragraph.28, lines 1-3] as taught by Dasan.**

As per **Claim 5**, the rejection of claim 4 is hereby incorporated by reference; Subramaniam does not disclose the field display unit updates the displayed data-entry fields immediately when the selection has been accepted.

However Dasan discloses the field display unit updates the displayed data-entry fields immediately when the selection has been accepted; **[user interface for editing a user profile is shown in FIGS. 9 and 10. For example, for a particular profile as displayed on screen 1000, any of the selection icons 1002-1010 may be selected for modification of that topic. At step 902 it is determined whether the user has selected the "delete" option for deleting topics from the profile (e.g. the selection of icon 1012 on screen 1000). If so, then the selected item(s) are deleted at step 904. Then it is determined at step 906 whether the user has selected the "add" icon 1014. If so, then the add option (process 700 of FIG. 7) is invoked at step 908. It is then determined at step 910 whether the generation of the newspaper based upon the profile is requested by the user;** paragraph.24, lines 1-10].

Subramaniam and Dasan are analogous art because they are from the same field of endeavor of Database information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Dasan. One having ordinary skill in the art would have found it motivating to use personalized information retrieval system of Dasan into the full-text search and query system of Subramaniam for the purpose retrieving data from a server based upon a defined and stored user profile of desired information; **[Paragraph.28, lines 1-3] as taught by Dasan.**

As per **Claim 7**, the rejection of claim 6 is hereby incorporated by reference; Subramaniam does not disclose the field display unit updates the displayed data-entry fields immediately when the selection has been accepted.

However Dasan discloses the field display unit updates the displayed data-entry fields immediately when the selection has been accepted; **[user interface for editing a user profile is shown in FIGS. 9 and 10. For example, for a particular profile as displayed on screen 1000, any of the selection icons 1002-1010 may be selected for modification of that topic. At step 902 it is determined whether the user has selected the "delete" option for deleting topics from the profile (e.g. the selection of icon 1012 on screen 1000). If so, then the selected item(s) are deleted at step 904. Then it is determined at step 906 whether the user has selected the "add" icon 1014. If so, then the add option (process 700 of FIG. 7) is invoked at step 908. It is then determined at step 910 whether the generation of the newspaper based upon the profile is requested by the user; paragraph.24, lines 1-10].**

Subramaniam and Dasan are analogous art because they are from the same field of endeavor of Database information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Dasan. One having ordinary skill in the art would have found it motivating to use personalized information retrieval system of Dasan into the full-text search and query system of Subramaniam for the purpose retrieving data from a

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server based upon a defined and stored user profile of desired information;

[Paragraph.28, lines 1-3] as taught by Dasan.

10. **Claim 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam et al. (U.S. 6,728,702) further in view of Greyvenstein et al.(U.S pub. 2001/0032200)

As per **Claim 10**, the rejection of claim 9 is hereby incorporated by reference; Subramaniam discloses a search purpose accepting subunit operable to accept, from the user, a selection of a desired search purpose from the displayed list of search purposes; **[the user can select a new search category and navigate to the appropriate view corresponding to the newly selected search category; paragraph.107, lines 7-9]**. Subramaniam does not disclose the apparatus is for searching a patent publication database, each search purpose corresponds to each phase in patent related procedures, and the search purpose accepting unit includes: a search purpose display subunit operable to display a list of search purposes in an order of the corresponding phases in the patent related procedures.

However Greyvenstein discloses disclose the apparatus is for searching a patent publication database, each search purpose corresponds to each phase in patent related procedures, and the search purpose accepting unit includes: a search purpose display subunit operable to display a list of search purposes in an order of the corresponding phases in the patent related procedures; **[guest access will allow an enquirer to view the various Patents by category (international patent**

classification or other suitable classification), by key word search, or by patent number search and/or by other criteria; paragraph.26, lines 1-4].

Subramaniam and Greyvenstein are analogous art because they are from the same field of endeavor of Patent information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Greyvenstein. The motivation being providing to all the relevant electronic documents housed in the data base will be displaced giving the user sufficient information; **[Paragraph.26, lines 7-9]** as taught by Greyvenstein.

11. **Claim 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramaniam et al. (U.S. 6,728,702), Dasan (5,761,662) and further in view of Greyvenstein et al.(U.S pub. 2001/0032200)

As per **Claim 12**, the rejection of claim 9 is hereby incorporated by reference; Subramaniam discloses a search purpose accepting subunit operable to accept, from the user, a selection of a desired search purpose from the displayed list of search purposes; **[the user can select a new search category and navigate to the appropriate view corresponding to the newly selected search category; paragraph.107, lines 7-9]**. Subramaniam does not disclose the apparatus is for searching a patent publication database, each search ID/purpose corresponds to each phase in patent related procedures, and the search purpose accepting unit includes: a search purpose display subunit operable to display a list of search purposes in an order of the corresponding phases in the patent related procedures.

Dasan discloses the search ID/purpose accepting unit; **[retrieving information based on a user-defined profile (e.g. a personalized newspaper). A user-controlled client establishes communication with a stateless server, the server presenting a list of options to the client (e.g. via Hypertext Transfer Protocol (HTTP) exchanges) between the server and the client. The client provides an identification of the user-defined profile. The server engages a first application program (e.g. via a Common Gateway Interface (CGI)), the first application program retrieving the user-defined profile wherein the user-defined profile identifies information which is of interest to the user; Paragraph.10, lines 1-10].**

Subramaniam and Dasan are analogous art because they are from the same field of endeavor of Database information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Dasan to provide the client application program retrieving data from a server based upon a defined and stored user profile of desired information; **[Paragraph.28, lines 1-3] as taught by Dasan.**

Greyvenstein discloses the apparatus is for searching a patent publication database, each search purpose corresponds to each phase in patent related procedures, a search purpose display subunit operable to display a list of search purposes in an order of the corresponding phases in the patent related procedures; **[guest access will allow an enquirer to view the various Patents by category (international patent classification or other suitable classification),**

by key word search, or by patent number search and/or by other criteria; paragraph.26, lines 1-4].

Subramaniam and Greyvenstein are analogous art because they are from the same field of endeavor of Patent information searching and retrieval.

Therefore, It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to combine the teachings of Subramaniam and Greyvenstein. The motivation being providing to all the relevant electronic documents housed in the data base will be displaced giving the user sufficient information; **[Paragraph.26, lines 7-9]** as taught by Greyvenstein.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cochran et al. (U.S. 5768581) discloses Apparatus and method for selecting records from a computer database by repeatedly displaying search terms from multiple list identifiers before either a list identifier or a search term is selected

Kerven et al. (US Pub. 2002/0042784) discloses System and method for automatically searching and analyzing intellectual property-related materials.

Helmbrech et al. (US 7120632) discloses Methods and system for managing business information on a website.

Allen et al. (US 6549940) discloses Graphical user interface for providing and facilitating user for searching and accessing information with options of selecting one of carrier circuit, facility reroute, customer and cable

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Snelling (US 5826257) discloses Method and structure for maintaining and utilizing an lookup value associated with a stored database value.

White et al. (US 2000051732) discloses Digital-project management system.

13. The examiner requests, in response to this Office action, support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

14. When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

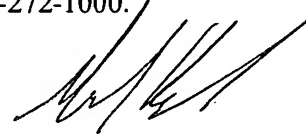

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherief Badawi whose telephone number is (571) 272-9782. The examiner can normally be reached on Monday through Friday 7:30-5:00, Alt Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pierre Vital can be reached on (571) 272-4215. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/14/2007

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Art Unit 2169
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